PR4

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,605	01/25/2001	Glenn Ricart	300/2	4396

27538   7590   07/30/2003

KAPLAN & GILMAN , L.L.P.
900NROUTE 9 NORTH
WOODBRIDGE, NJ   07095

EXAMINER
HANNE, SARA M

ART UNIT	PAPER NUMBER
2173	6

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

		Application N . ●		Applicant(s)	
;	**Offic Action Summary**	09/769,605		RICART ET AL.	
		Examiner		**Art Unit**	.
		Sara M Hanne		2173	

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 7-16* is/are rejected.

7)☒ Claim(s) *6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*25 January 2001*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____

U.S. Patent and Trademark Office

DETAILED ACTION

Information Disclosure Statement

1.   The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Applicant is requested to cite this reference on an Information Disclosure Statement submitted in accordance with 37CFR1.98 and include a copy.

Oath/Declaration

2.   The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because:
> Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Alterations have been made to the oath as seen on page 2 of the oath removing the inventor Robert Burnett and have not been initialed and dated.

Specification

3.   The abstract of the disclosure is objected to because parentheses are used as

such "to the new (or upgraded) servers". The parentheses should be removed from the

abstract reworded appropriately. Correction is required. See MPEP § 608.01(b).

Claim Objections

4.   Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. The claim is written in the

form of a preamble made to depend on another claim. The stated preamble is not given

patentable weight as it fails to breathe life, meaning, and vitality into the claims. As

such, the claim fails to further limit the subject matter of the claim(s) upon which they

depend. See MPEP §§ 608.01(n) and 2111.02.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claim 4, 5, 7-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention. The term "at least partially personalized" is not fully taught in the specification

and fails to enable one to control the server in the manner claimed.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claims 2 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding Claim 2, the phrase "for example" renders the claim indefinite

because it is unclear whether the limitation(s) following the phrase are part of the

claimed invention. See MPEP § 2173.05(d). This is seen in line 3 of claim 2, "e.g.".

Also the phrase "etc." further renders the claim indefinite.

The term "the client and server are generic" in claim 16 is a relative term which

renders the claim indefinite. The term " the client and server are generic " is not defined

by the claim, the specification does not provide a standard for ascertaining the requisite

degree, and one of ordinary skill in the art would not be reasonably apprised of the

scope of the invention. This term attempts to claim an overly broad range of information

that is rejected below.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

10.   Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by

Norris, U.S. Patent No. 5557748. In accordance to claim 1, Norris discloses "user

preferences and network parameters" to be transmitted across the network between

server and client (Col. 2, line 9 and Table 1 of Norris). For the first connection, the

network snoops for network configuration information, which qualifies as personalization

information, prior to utilizing the device across a network (Col. 10, line 33 of Norris).

Claim 2 is dependent upon Claim 1 and in addition teaches that the information sent

must be at least one of "the server's name, the domain in which it resides . . .". The

server's name and/or domain is part of the information needed to configure the network

as Norris teaches, and therefore Claim 2 can also be rejected (Col. 10, line 14 of

Norris). Norris teaches all of the information regarding the physical sending of the

information as in Claim 1's rejection above. Claim 3 is dependent upon Claim 1 and

also teaches that the information sent must be at least one of "identification of a

'Documents and Settings' directory for a user, Windows operating system registry

information, and corporate policy information." The background art in this patent

application does refer to prior art listed on novell.com in the form of software that ⌐

collect the Desktop policies and profiles, which would include registry information and corporate policy information.

Claim 7 of this application discloses information about personalizing the server and the client being sent to the server and utilizing it's own information and sending the client personalization information to the client. Norris teaches the sending of client personalization information from the client and server and vice versa and that once you have logged onto the server, you will be able to retrieve this information (Col. 10, line 33 of Norris). He does not teach the sending of, specifically server, personalization information to the server and to be passed down to the client by the server. This information is so notoriously known, the examiner takes official notice of this teaching. Therefore, it would have been obvious to one skilled in the art with the teachings of Norris to construct this flow of information to the server and from there to the client. One of ordinary skill in the art would be motivated to do this in order to make sure the information is saved globally by a provider or another server up the hierarchy and to ensure it is distributed appropriately.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative,

under 35 U.S.C. 103(a) as obvious over Norris, U.S. Patent No. 5557748.

        In accordance to Claim 8 Norris teaches all of the information regarding the

physical sending of the information as rejected in Claim 1. Norris discusses that user

preferences and network parameters for a specific computer are read or entered into

memory on that computer at the time of logon, this information having been saved on

the network (Col. 10, line 33 of Norris). It is notoriously well known that the

personalization information loaded onto the computer at the time of logon could be

saved on the hard drive and therefore be disconnectable from the network on a laptop.

The examiner takes official notice of this teaching. Therefore, it would be obvious to

one of ordinary skill in the art having the teachings of Norris to combine the methods of

sending and types of "personalization information" between a terminal and host and

saving this information on the hard drive. One of ordinary skill in the art would be

motivated to combine this information to keep a hard copy of the information on the

terminal so that it may be disconnected from the network and still possess the

personalization or cached information as known in the art.

13.   Claims 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Norris as applied to claim 7 above, and further in view of Aaker et al., U.S. Patent

6011915. Claim 12 claims a method of replacement of hardware using a system like

that in Claim 7. Norris teaches a method in which user preferences and network

parameters for a specific computer are read or entered into memory on that computer at

the time of logon, this information having been saved on the network (Col. 2, line 9 of

Norris). Norris does not teach replacement of hardware. Aaker et al. (Col. 4, lines 33-

53 of Aaker) teaches a method of removing hardware and replacing it with new

hardware to be personalized by it's server. In accordance to Claims 14 and 15, Norris

has previously taught the claimed net information and user information in the application

as "network information" and "user preferences" (Col. 2, line 9). It would be obvious to

one skilled in the art with the teachings of Norris and Aaker et al. to replace the

hardware as shown by Aaker et al. whilst retaining the aforementioned personalization

information from the server taught by Norris. One would be motivated to do so in order

save time and money that would have been spent reconfiguring the client, as supported

by Aaker et al.

14.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norris

and Aaker et al. as applied to claim 12 above, and further in view of Mosher et al.,

U.S. Patent 6029143. Claim 13 is dependent upon 12 and further states that the

personalization information should be stored with a remote service provider. With

respect to Claim 13, Aaker et al. and Norris *supra,* teach a method in which user

preferences and network parameters for a specific computer are read or entered into

memory on that computer at the time of logon, this information having been saved on

the network (Col. 2, line 9 of Norris) along with replacement of the hardware (Col. 4,

lines 33-53 of Aaker). However, they fail to teach saving the said information with a

remote service provider. Mosher et al. teaches information (ordering data) to be

stored with a remote service provider (Col. 10, line 24 of Mosher et al.). One who is

skilled in the art with the teachings of Aaker et al., Norris and Mosher would conclude

that if the information can be stored on the server and transmitted across the

network, it can just as easily be sent to and stored on a remote service provider as

Mosher did with ordering data. Accordingly, it would have been obvious to one of

ordinary skill in the art, having the teachings of Aaker et al., Norris and Mosher

before him at the time the invention was made, to modify the method of

transmitting said information and hardware replacement taught by Aaker et al.

and Norris to include the saving of information with a remote service provider of

Mosher, in order to obtain the method claimed. One would be motivated to do so

in order to keep a global copy of this information in the case of server replacement or

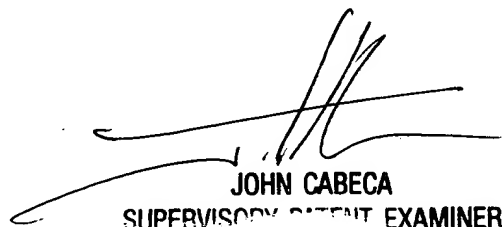failure as taught by Mosher.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered

pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to

consider these references fully when responding to this action. The documents cited

therein teach further examples of personalization information exchange between clients

and servers and hardware replacement with remote computer systems.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sara M. Hanne whose telephone number is (703) 308-

0703. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers

for the organization where this application or proceeding is assigned are N/A for regular

communications and N/A for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 306-

5484.

smh
July 25, 2003

JOHN CABECA
SUPERVISORY PATENT EXAMINER